

Application No. 10/083,288  
Reply to Office Action dated September 30, 2004

### **REMARKS/ARGUMENTS**

Applicants have carefully reviewed the Office Action dated September 30, 2004, regarding the above-referenced patent application. Currently claims 1-26 are pending in the application, wherein claims 1-26 have been rejected by the Examiner. Claims 1 and 2 have been amended with this Amendment. Favorable consideration of the above amendments and following remarks is respectfully requested.

#### **Claim Objections**

Claim 1 is objected to because of an apparent grammatical error, namely, the term "couple" should read "coupled." Claim 1 has been amended in order to overcome this objection. Applicants respectfully request withdrawal of this objection.

Claim 2 is objected to because it contains informalities. Claim 2 has been amended by replacing the term "said actuatable tip" with "said actuatable stop." Applicants assert this amendment overcomes the objection and withdrawal of this objection is requested.

Claim 16 is objected to because it contains Dacron, which the Examiner asserts is a trademarked name, and therefore cannot be claimed. Applicants respectfully traverse this objection. Applicants assert that the use of a trademark is allowable if the trademark has a fixed and definite meaning and the product to which the product refers is set out in clear language in the specification. See M.P.E.P. §608.01(v). Results from a cursory patent search on the USPTO website reveal that 259 patents issued to date contain Dacron in at least one claim. Applicants assert that Dacron has gained a fixed and definite meaning in the industry as a polymer material having suitable medical characteristics. Furthermore, Dacron has been clearly described in the specification as a synthetic polyester material used for its strength and biocompatibility available from E. I. du Pont de Nemours and Company located in Wilmington, Delaware. (See page 10, lines 5-8). Therefore, Applicants assert the use of Dacron in claim 16 has a clear and definite meaning and withdrawal of the objection is requested.

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## Claim Rejections

### 35 U.S.C. §102

Claims 1-10 and 17-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by Levinson et al., U.S. Patent No. 6,277,139 (hereinafter Levinson). The Examiner asserts that Levinson teach each element of the rejected claims. Applicants respectfully traverse this rejection.

Claims 1 and 10 each teach an actuatable stop moveable between a collapsed position and an expanded position. Applicants assert Levinson fails to teach at least this limitation of the claimed invention. Levinson seems to disclose a stop 16 mounted near the distal end of the guide wire 12. (col. 6, lines 28-29). However, Levinson fails to teach a stop which is moveable between a collapsed position and an expanded position as currently claimed. The stop 16 disclosed in Levinson appears to be stationary, having a single fixed position. If the Examiner wishes to maintain this rejection, the Examiner is requested to clearly identify where Levinson teaches an actuatable stop moveable between a collapsed position and an expanded position.

An actuatable stop moveable between a collapsed position and an expanded position may be advanced through the vasculature in the collapsed position, thereby retaining a low profile. The actuatable stop may then be moved to the expanded position in order to restrain the longitudinal movement of additional medical devices advanced along the guidewire. Levinson clearly fails to teach at least this element of the claimed invention.

For the reasons stated above, claims 1 and 10 are clearly patentable over Levinson. Claims 2-9 and 17-22 depend from either claim 1 or claim 10 and include additional significant limitations; therefore, these claims are also believed to be in condition for allowance.

Claims 23-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by Dubrul et al., U.S. Patent No. 6,602,265 (hereinafter Dubrul et al.). The Examiner asserts that Dubrul et al. disclose an intravascular tissue separation method including all of the limitations claimed in the current invention. Applicants respectfully traverse this rejection.

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Applicants respectfully assert Dubrul et al. fail to teach a method for placing an articulating guidewire in the vasculature as currently claimed. Dubrul et al. seem to teach a method of removing tissue from the body, and the use of a guidewire is incidental to the teachings of Dubrul et al.. Clearly, Dubrul et al. fail to teach the use of an articulating guidewire having an actuatable stop moveable between a collapsed position and an expanded position.

Initially, Dubrul seem to teach a trapping device (TRAP) 12 including a malecot type mechanism 6 on the distal portion of a catheter. The malecot mechanism has deployed and undeployed states. However, this TRAP is a distal portion of a catheter and not a portion of a guidewire. (See col. 6, lines 50-52). For example, Dubrul et al. teach that the TRAP may be inserted into a vessel by a guidewire 3. (See col. 6, lines 63-64). Therefore, the TRAP is a portion of a catheter, not an articulating guidewire. However, this is clearly not what is claimed in claims 23-26. Furthermore, the TRAP (a portion of the catheter) appears to be the only element of Dubrul et al. moveable between a collapsed position and an expanded position.

The Examiner also directs the Applicants to column 7, lines 51-67 of Dubrul et al.. Here, Dubrul et al. teach an inner wire or tube 15 may be used for actuation of a braided TRAP as shown in Figure 3. However, the present invention is clearly not disclosed by these teachings either. Dubrul et al. state "the inner wire or tube 15 may be a tube when a guide wire is used." (col. 7, lines 63-64). Therefore, the inner wire or tube 15 necessarily is not a guidewire since the inner wire or tube 15 is configured to engage a guidewire when a guidewire is used. It is apparent from these teachings of Dubrul et al. that if a guidewire were used, the guidewire would be disposed within tube 15 and extend through exit hole 16 in the distal tip 17. (See col. 7, lines 63-67). Therefore, no portion of a guidewire, within the scope of the teachings of Dubrul et al., includes an actuatable stop moveable between a collapsed position and an expanded position.

Consequently, Applicants assert the teachings of Dubrul et al. fail to include an actuatable stop moveable between a collapsed position and an expanded position. Therefore, it is impossible for Dubrul et al. to teach at least the steps of "providing an articulating guidewire comprising...an actuatable stop...moveable between a collapsed position and an

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expanded position" and "actuating the actuatable stop from the collapsed position to the expanded position" as claimed in claims 23 and 25. For at least these reasons, Dubrul et al. clearly fails to teach what is claimed in claims 23-26. Applicants assert claims 23-26 are currently in condition for allowance.

### 35 U.S.C. §103

Claims 13, 15 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Levinson et al., U.S. Patent No. 6,277,139 (hereinafter Levinson) in view of Dubrul et al., U.S. Patent No. 6,602,265 (hereinafter Dubrul et al.). Applicants respectfully traverse this rejection.

Applicants assert a prima facie case of obviousness has not been established at least because each and every element of the claimed invention is not taught by the combination of references. The deficiencies of both Levinson and Dubrul et al. have been discussed above in detail. It is apparent from the above remarks that neither Levinson nor Dubrul et al. teach an articulating guidewire having an actuatable stop moveable between a collapsed position and an expanded position as currently claimed in claim 10. Their independent shortcomings are not remedied by their combination. Applicants assert claims 13, 15 and 16 depend from claim 10 and contain significant additional elements. Therefore, due to the deficiencies disclosed above, no prima facie case has been established by the cited combination of references. Applicants assert claims 13, 15 and 16 are currently in condition for allowance.

Claims 11, 12 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Levinson et al., U.S. Patent No. 6,277,139 (hereinafter Levinson) in view of Tate, U.S. Patent No. 3,841,308 (hereinafter Tate). Applicants respectfully traverse this rejection.

Applicants assert a prima facie case of obviousness has not been established at least because each and every element of the claimed invention is not taught by the combination of references. As stated above regarding claim 10, Levinson at least fail to teach an articulating guidewire having an actuatable stop moveable between a collapsed position and an expanded position. Applicants assert Tate fails to overcome the deficiencies of Levinson. Tate seems to teach a distally valved catheter device. However, Tate fails to teach a guidewire, let alone a guidewire as currently claimed. Applicants assert neither Levinson, Tate, nor their

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combination teach each and every element as claimed in claim 10. Claims 11, 12 and 14 depend from claim 10 and add significant additional elements; therefore, they are believed to be in condition for allowance.

Additionally, Applicants assert there is no motivation, either express or inherent, to combine the cited references as required to establish a prima facie case of obviousness. One would not look to a distally valved catheter device used to disrupt the flow of fluids to rectify the shortcomings of a vascular protection and embolic material retrieval device used to trap and remove embolic material from the vascular system. The two inventions disclosed in the prior art attempt to solve distinct problems. One of skill in the art would not seek to combine the teachings of Levinson with those of Tate.

Applicants assert that for the above reasons a prima facie case has not been established with regard to the cited references. Therefore, claims 11, 12 and 14, which depend from claim 10, are likewise believed to be in condition for allowance.

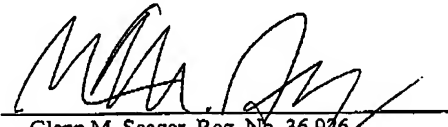
#### Conclusion

Reexamination and reconsideration of all pending claims, namely claims 1-26, is respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
Anthony C. Vrba et al

By their attorney,

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